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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,238	09/08/2003	Nathalie Mougin	05725.0570-01	1859

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EXAMINER

ROYDS, LESLIE A

ART UNIT	PAPER NUMBER
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1614

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	01/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/656,238

Applicant(s)

MOUGIN, NATHALIE

Examiner

Leslie A. Royds

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-52 and 54-61 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 41-52, 54-61 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/544,655.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claims 41-52 and 54-61 are presented for examination.

Claims 1-40 and 53 were cancelled pursuant to the Preliminary Amendment dated

September 8, 2003.

Requirement for Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 41-52 and 54, drawn to a hair composition comprising at least one polymer having a star structure defined by formula (I), classified in class 514, subclass 772.3, for example, depending on the polymer used.
- II. Claims 55-58, drawn to a method for retaining or shaping the hair comprising the application of a composition comprising at least one polymer having a star structure defined by formula (I) to said hair, classified in class 514, subclass 772.3, for example, depending on the polymer used.
- III. Claims 59-61, drawn to a process for preparing a styling product comprising a composition comprising at least one polymer having a star structure defined by formula (I), classified in class 514, subclass 772.3, for example, depending on the polymer used.

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the product as claimed can be used in a materially different process of using that product, namely, for use as a nail varnish.

Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to

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make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process, namely, via a method of atom transfer radical polymerization.

Inventions II and III are directed to related processes. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j).

In particular, Inventions II and III are related because they recite the use of at least one polymer having a star structure in an amount effective for retaining and/or shaping the hair. However, Invention II is directed to a process of using said polymer having a star structure for application directly to the hair for retaining and/or shaping the hair, wherein the amount of is effective to achieve such an objective. The method of Invention III is directed to the use of at least one polymer having a star structure in an amount effective for retaining and/or shaping the hair for the preparation of a styling product. Accordingly, the processes of Inventions II and III clearly have different functions and/or effects.

Further, Inventions II and III comprise steps that are not required for any other method. Invention II requires the application of the polymer having a star structure directly to hair in an amount effective to retain and/or shape the hair. Invention III requires the incorporation of the polymer having a star structure in an amount effective to retain and/or shape the hair into an acceptable medium for producing a styling product.

Accordingly, the modes of operation, functions and/or effects of the methods are clearly distinct from one another, despite the fact that the Inventions are related solely on the basis of the use of at least one polymer having a star structure in an amount effective for retaining and/or shaping the hair. In view of the fact that the inventions as claimed do not encompass overlapping subject matter and there is

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nothing of record to show them to be obvious variants, the inventions are properly held to be patentably distinct from one another.

Because these inventions are distinct for the reasons given above, they require a different field of search (see MPEP § 808.02) and they have acquired a separate status in the art because of their recognized divergent subject matter, the requirement for election for examination purposes as indicated is proper.

Election of Species Requirement

This application contains claims directed to patentably distinct species of polymer having a star structure defined by Formula (I) (claims 41-52 and 54-61).

The species are independent or distinct because the species of polymers recited in the present claims are structurally and/or chemically distinct from any one other compound encompassed by the present claims such that a comprehensive search of the patent and non-patent literature for any one such polymer would not necessarily result in a comprehensive search of any one or more or all of the other polymers encompassed by the claims. Notwithstanding that Applicant may have established an underlying common function to this broad genus of polymers, namely, that they are amenable for use as hair styling products, it remains that the art does not necessarily recognize such a shared function as being common to each of the variety of distinct compounds encompassed by the claims. It is also noted that the art may have recognized a different advantage or benefit to any one or more of these compounds that differs from the advantage that Applicant has discovered and, thus, the search for any one compound would not necessarily encompass a comprehensive search for any one other compound presently claimed. Furthermore, the disparate nature and variability encompassed by this broad genus of compounds precludes a quality examination on the merits not only because a burdensome search would be required for the entire scope of the claim(s), but also because consideration of the findings of such a search for

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compliance with the statutes and requirements set forth under 35 U.S.C. 101, 102, 103 and 112 would be unduly onerous. In addition, the discovery of any one of the presently claimed polymers for use in a composition would not necessarily anticipate or reasonably suggest or render obvious the use of any one or more of the other polymers claimed for the same objective.

Election of species should be made consistent with the following instructions:

Election of any one of Groups I, II or III requires the election of a **single disclosed specie** of polymer having a star structure defined by Formula (I).

Election of any one single disclosed specie of polymer having a star structure may be made from those polymers specifically claimed (see, e.g., claims 41-52 and 54-61).

Applicant is cautioned that the election of a particular specie of polymer having a star structure, wherein the elected specie is not adequately supported by the accompanying specification, may raise an issue of new matter under the written description requirement of 35 U.S.C. 112, first paragraph.

Currently, claims 41-52 and 54-61 are generic.

Applicant is advised that a reply to this requirement must include an **identification of the single disclosed species of polymer having a star structure of Formula (I)** [including defining the identity of each moiety (i.e., A, M1, M2, p, n, etc.) contained within the compound] and a **structural depiction of the elected species** that is elected consonant with this requirement and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, Applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, Applicant must indicate which are readable upon the elected species. Please reference MPEP §809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election

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of a species or invention to be examined even though this requirement be traversed (37 C.F.R. 1.143) and (ii) an identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should Applicant traverse on the ground that the inventions or species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The Examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP §821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 C.F.R. 1.116; amendments submitted after allowance are governed by 37 C.F.R. 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 C.F.R. 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and

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process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. §103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicants are advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder.

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP §804.01.

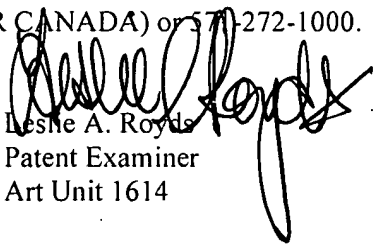
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie A. Royds whose telephone number is (571)-272-6096. The examiner can normally be reached on Monday-Friday (9:00 AM-5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on (571)-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Lesne A. Royds
Patent Examiner
Art Unit 1614

January 3, 2007


ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER